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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,927	08/06/2003	David M. Sherr	039238-0301	1054
23524	7590	10/06/2006		EXAMINER
FOLEY & LARDNER LLP				CAMPBELL, JOSHUA D
150 EAST GILMAN STREET				
P.O. BOX 1497			ART UNIT	PAPER NUMBER
MADISON, WI 53701-1497				2178

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/635,927	SHERR, DAVID M.
	Examiner Joshua D. Campbell	Art Unit 2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/6/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

1. This action is responsive to communications: Application filed 8/6/2003 and IDS filed 8/6/2003.
2. Claims 1-21 are pending in this case. Claims 1, 12, 18, and 21 are independent claims.

### ***Drawings***

3. The drawings were received on 8/6/2003. These drawings are accepted.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-9 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell, Jr. (hereinafter O'Donnell, US Patent Number 6,573,887, issued on June 3, 2003) in view of McAnaney et al. (hereinafter McAnaney, US Patent Application Publication 2002/0087562, published on July 4, 2002, disclosed in IDS).

**Regarding independent claim 1,** O'Donnell discloses receiving electronic information from a device at the same time the hand-written version of the document is created (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell discloses that certification of the information is received from the device (column 2, line 65-column 4,

line 20 of O'Donnell). O'Donnell discloses storing the certified document and making it accessible for retrieval over a network (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell does not disclose that the certification information is associated with a second party. However, McAnaney discloses that a document (invention disclosure) is generated and then sent on to at least one more party to be certified (page 1, paragraphs 0008-0009 and page 5, paragraphs 0058-0059 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of O'Donnell with the teachings of McAnaney because it would have allowed users other than the author to value the document for future decision-making.

**Regarding dependent claims 2-5,** O'Donnell discloses that the electronic version of the document is stored on the electronic pen at which point a communication session is established to send the document to a computer that is coupled to a network of computers (column 2, line 65-column 4, line 20 of O'Donnell).

**Regarding dependent claims 6 and 7,** O'Donnell discloses that the pen may be transmit to the computer via a docking station or via wireless communication technology (column 2, line 65-column 4, line 20 of O'Donnell).

**Regarding dependent claims 8 and 9,** O'Donnell discloses that when the document is certified it can no longer be edited (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell does not disclose that the certification information is received separate from the document. However, McAnaney discloses that a document (invention disclosure) is generated and then sent on to at least one more party to be

certified, the certification being generated separately (page 1, paragraphs 0008-0009 and page 5, paragraphs 0058-0059 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of O'Donnell with the teachings of McAnaney because it would have allowed users other than the author to value the document for future decision-making.

**Regarding independent claim 12,** O'Donnell discloses receiving electronic information from a device at the same time the hand-written version of the document is created (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell discloses that certification of the information is received from the device (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell discloses that up until the document is certified it may be edited or annotated (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell does not disclose that the certification information is associated with a second party. However, McAnaney discloses that a document (invention disclosure) is generated and then sent on to at least one more party to be certified (page 1, paragraphs 0008-0009 and page 5, paragraphs 0058-0059 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of O'Donnell with the teachings of McAnaney because it would have allowed users other than the author to value the document for future decision-making.

**Regarding dependent claims 13 and 14,** O'Donnell discloses that interruptions may takes place during a page session (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell does not disclose that the document includes date and time stamps. McAnaney discloses that documents are date stamped when they are

authored (page 6, paragraphs 0067-0068 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of O'Donnell with the teachings of McAnaney because it would have allowed for the documents to be indexed and searched by date.

**Regarding dependent claims 15 and 16,** O'Donnell does not disclose provided database interface search capabilities or organizing the documents using semantic structure. However, McAnaney discloses providing a database search interface and organizing documents using semantic structures (page 6, paragraphs 0067-0068 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of O'Donnell with the teachings of McAnaney because it would have allowed for the documents to be indexed and searched.

**Regarding dependent claim 17,** O'Donnell discloses a digital pen used as an input device. O'Donnell does not disclose requiring the use of two separate pens to perform the authoring and the certification. However, McAnaney discloses performing the authoring with one computer and the certification with a different computer both of which have their own input devices (page 1, paragraphs 0008-0009 and page 5, paragraphs 0058-0059 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the digital pen of O'Donnell as a possible input device for the system of McAnaney because it would have allowed for the pen-created documents to be indexed and searched.

**Regarding independent claim 18,** O'Donnell discloses receiving electronic information from a device at the same time the hand-written version of the document is created (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell discloses that certification of the information is received from the device (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell discloses storing the certified document and making it accessible for retrieval over a network (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell does not disclose that the certification information is associated with a second party. O'Donnell does not disclose provided database interface search capabilities or organizing the documents using semantic structure. However, McAnaney discloses that a document (invention disclosure) is generated and then sent on to at least one more party to be certified (page 1, paragraphs 0008-0009 and page 5, paragraphs 0058-0059 of McAnaney). McAnaney also discloses providing a database search interface and organizing documents using semantic structures (page 6, paragraphs 0067-0068 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of O'Donnell with the teachings of McAnaney because it would have allowed for the documents to be indexed and searched.

**Regarding dependent claims 19 and 20,** O'Donnell discloses receiving electronic information from a device at the same time the hand-written version of the document is created (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell discloses that certification of the information is received from the device (column 2, line 65-column 4, line 20 of O'Donnell). O'Donnell does not disclose requiring the use of

two separate pens to perform the authoring and the certification. However, McAnaney discloses performing the authoring with one computer and the certification with a different computer both of which have their own input devices (page 1, paragraphs 0008-0009 and page 5, paragraphs 0058-0059 of McAnaney). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the digital pen of O'Donnell as a possible input device for the system of McAnaney because it would have allowed for the pen-created documents to be indexed and searched.

**Regarding independent claim 21,** the claim incorporates substantially similar subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim 1.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell, Jr. (hereinafter O'Donnell, US Patent Number 6,573,887, issued on June 3, 2003) in view of McAnaney et al. (hereinafter McAnaney, US Patent Application Publication 2002/0087562, published on July 4, 2002, disclosed in IDS) as applied to claim 1 above, and further in view of Craft et al. (hereinafter Craft, US Patent Number 6,704,739, filed on January 4, 1999).

**Regarding dependent claims 10 and 11,** neither O'Donnell nor McAnaney disclose using search tags in the documents based on content analysis. However, Craft discloses creating concept based search tags in documents (column 1, line 25-column 2, line 44 of Craft). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to have combined the teachings of O'Donnell and McAnaney with the teachings of Craft because it would have provided an improved method in concept based information retrieval.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 6,104,388 A

US Patent Number 6,985,643 B1

US Patent Application Publication Number 2002/0090149 A1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDC  
September 29, 2006

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER